

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD E. WILLIAMS, MICHAEL R. LEE and
DAN M. McDONALD

Appeal No. 95-4897
Application 08/242,806¹

ON BRIEF

Before KRASS, JERRY SMITH and FLEMING, ***Administrative Patent Judges.***

FLEMING, ***Administrative Patent Judge.***

DECISION ON APPEAL

¹Application for patent filed May 13, 1994. According to appellants, this application is a continuation of application 08/111,775, filed August 25, 1993, abandoned, which is a continuation of application 07/962,011, filed October 15, 1992, abandoned, which is a continuation of application 07/831,628, filed February 6, 1992, abandoned, which is a continuation of application 07/517,923 filed May 2, 1990, abandoned.

This is a decision on appeal from the final rejection of claims 6 through 10. Claims 1 through 5 have been canceled.

The invention relates to the field of cellular telephones. In particular, Appellants disclose on page 5 of the specification that Figure 1 shows an embodiment of the base station 100 implemented with three transceivers 121, 122 and 123, each switchable to a voice channel or to a control channel. On page 7 of the specification, Appellants disclose that Figure 3 shows the possible transceiver states of the three transceivers. In particular, Appellants disclose that the system allows for all three transceivers to be in the voice channel state. This places the system in a busy state because of unavailability of a control channel. The busy state results in the system being unable to respond to an incoming call. This is because there is a temporary inactivation of the control channel because all three transceivers are in the voice channel state.

The independent claim 6 is reproduced as follows:

6. A method for operating a radiotelephone base station including one or more standard cellular telephone cell site transceivers to allow standard cellular telephone terminals to set up and communicate over a wire line, said method comprising the steps of:

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- A) tuning a first transceiver in said base station unit to a control channel only if said first transceiver is not engaged in voice communications;
- B) receiving a set up request from one of said cellular telephone terminals over said control channel;
- C) signalling said cellular telephone terminal to tune to a voice channel in response to receiving said set up request;
- D) tuning said first transceiver to said voice channel regardless of whether this results in no transceiver in said base station unit being tuned to said control channel;
- E) placing a wire line telephone call at said base station unit in accordance with said set up request;
- F) communicating with said cellular telephone terminal over said voice channel; and
- G) tuning said first transceiver to said control channel upon completion of said communication only if no other transceiver in said base station unit is then tuned to said control channel.

The Examiner relies on the following references:

Kavehrad et al. (Kavehrad)	4,672,658	Jun. 09, 1987
Murata et al. (Murata)	4,939,785	Jul. 03, 1990

In the final action, claims 6 and 7 stand rejected under

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35 U.S.C. § 103 as being unpatentable over Murata. Claims 8 through 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Murata and Kavehrad.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the briefs² and answer for the respective details thereof.

OPINION

After a careful review of the evidence before us, we do not agree with the Examiner that claims 6 through 10 are properly rejected under 35 U.S.C. § 103.

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6

²Appellants filed an appeal brief on January 9, 1995. We will refer to this appeal brief as simply the brief. Appellants filed a reply appeal brief on April 24, 1995. The Examiner stated in the Examiner's letter, mailed May 17, 1995, that the reply brief has been entered and considered but no further response by the Examiner is deemed necessary.

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(Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 117 S.Ct. 80 (1996) ***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984).

In regard to the rejection of claims 6 and 7 as being unpatentable over Murata and the rejection of claims 8 through 10

as being unpatentable over Murata and Kavehrad, Appellants argue

on pages 5 through 7 of the brief that Murata fails to teach a temporary inactivation of the control channel. Appellants argue that this feature is claimed in each of the independent claims. Appellants state on the bottom of page 5 and on the top of page 6 the following:

This feature, which will from time to time result in temporary unavailability of the central channel, is

recited in paragraph D of claim 6. Similar recitations are contained in paragraph H of claim 8 and paragraph D(iii) of claim 10.

Appellants argue that Murata teaches to those skilled in the art that at all times the control channel is monitored by a transceiver. Appellants further argue Murata fails to suggest to those skilled in the art to modify this requirement of always monitoring the control channel by a transceiver.

Upon our review of Murata, we fail to find that Murata teaches allowing the control channel to not be monitored as recited in Appellants' claims. In the abstract, Murata makes it clear that at least one of the connecting equipment units is kept in the first control mode, a mode where the control is monitored by the connecting equipment. In column 1, lines 45-68, Murata points out that it is not desirable for the connecting equipment

units to not always monitor the control channel because this would result in prolongation of a response to the a call in the control station. Murata states that this prolongation is because the connecting equipment cannot respond to the call. In column 2, lines 12-15, Murata states that it is the object

of the invention to provide a control station which can always monitor a control channel without any interruption of monitoring the control channel. Murata teaches in column 5, lines 13-24, that one connecting equipment unit always monitors the control channel in each radio connecting section in the radio communication network system illustrated in Figure 1. In addition, upon a review of Kavehrad, we fail to find any teaching or suggestion to allow the control channel to not be monitored.

Furthermore, we fail to find any reason to modify Murata to obtain Appellants' claimed invention. The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself

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as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability. *IN RE DENIS ROUFFET*, 97-1492 (Fed. Cir. decided July 15, 1998).

We have not sustained the rejection of claims 6 through 10 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

Reversed

ERROL A. KRASS)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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MICHAEL R. FLEMING)	
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